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OFFICE OF PETITIONS

ON PETITION

In re Application of
Wilbuer, et al.
Application No. 09/856,814
Filed: August 13, 2001
Attorney Docket No. SWR-005
For: COATING CONSISTING OF A SYNTHETIC
FILM, PROCESS AND DEVICE FOR
PRODUCING THE SAME

This is a decision on the petition under 37 CFR 1.137(a), filed June 23, 2005 (certificate of mailing date June 21, 2005), to revive the above-identified application under the unavoidable delay standard. In the alternative, petitioners request revival under 37 CFR 1.137(b), which is the unintentional delay standard.

The petition under 37 CFR 1.137(a) is **DISMISSED**.

The petition under 37 CFR 1.137(b) is **GRANTED**

The above-identified application became abandoned for failure to properly reply to the final Office action, mailed November 5, 2004. Petitioner filed an improper RCE and a request for a 2 month extension of time on April 5, 2005. The RCE was improper because petitioners failed to file a submission in compliance with 37 CFR 1.114. No further extensions of time being obtained and no submission being filed, the application became abandoned on April 6, 2005. On June 7, 2005, the Office mailed a Notice of Abandonment.

A grantable petition to revive an abandoned application under 37 CFR 1.137(a) must be accompanied by (1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof; (2) the petition fee as set forth in § 1.17(l); (3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable; and (4) any terminal disclaimer (and fee as set forth in § 1.20 (d)) required pursuant to paragraph (c) of this section. This petition does not satisfy requirement (3).

Regarding (3), the showing of record is inadequate to establish unavoidable delay within the meaning of 37 CFR 1.137(a). Specifically, an application is "unavoidably" abandoned only where petitioner, or counsel for petitioner, takes all action necessary for a proper response to the

outstanding Office action, but through the intervention of unforeseen circumstances, such as failure of mail, telegraph, telefacsimile, or the negligence of otherwise reliable employees, the response is not timely received in the Office. Ex parte Pratt, 1887 Dec. Comm'r Pat. 31 (Comm'r Pat. 1887).

The Commissioner may revive an abandoned application if the delay in responding to the relevant outstanding Office requirement is shown to the satisfaction of the Commissioner to have been "unavoidable". 35 U.S.C. § 133. Decisions on reviving abandoned applications have adopted the reasonably prudent person standard in determining if the delay was unavoidable. Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (Comm'r Pat. 1887)(the term 'unavoidable' "is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business"); In re Mattullath, 38 App. D.C. 497, 514-15 (D.C. Cir. 1912); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (Comm'r Pat. 1913). In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition to revive an application as unavoidably abandoned cannot be granted where a petitioner has failed to meet his or her burden of establishing the cause of the unavoidable delay. Haines v. Quigg, 673 F. Supp. 314, 5 USPQ2d 1130 (N.D. Ind. 1987).

In the instant case, petitioners have failed to establish that the delay was unavoidable. Petitioners assert that the entire delay was unavoidable because the Office did not mail a Notice of Improper Request for Continued Examination upon receipt of the improper RCE, thereby denying petitioners notice that the RCE was improper and the opportunity to remedy their filing omission.

As stated in MPEP 706.07(h) III A. *Treatment of Improper RCE*, "...An improper RCE will not operate to toll the running of any time period set in the previous Office action for reply to avoid abandonment of the application...." The rules of practice are clear that prosecution of an application to save it from abandonment must include such complete and proper action as the condition of the case may require. This is an applicant's burden, not the Office's burden. Petitioners admittedly failed to file a proper reply to the November 5, 2004 Office action. This failure occurred because petitioners did not exercise the due care of a reasonably prudent man in relation to his most important business. The delay was not unavoidable.

The petition under 37 CFR 1.137(a) is **DISMISSED**.

Petitioners alternatively petition under 37 CFR 1.137(b) for revival under the unintentional delay standard. Petitioners have submitted a reply in the form of a RCE and submission in compliance with 37 CFR 1.114, an acceptable statement of the unintentional nature of the delay in responding to the November 5, 2004 final Office action, and the petition fee.¹

The petition under 37 CFR 1.137(b) is **GRANTED**.

After the mailing of this decision, the application will be forwarded to Technology Center 1700's technical support staff for processing the submission filed with the instant petition.

¹ Pursuant to petitioners' authorization, deposit account no. 06-1130 will be charged the required \$750.00 petition fee.

Telephone inquiries pertaining to this matter may be directed to the undersigned at (571) 272-3230.



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